

REMARKS

I. Introduction

Claims 7-19 are pending in the above application.

Claims 7-19 stand rejected under 35 U.S.C. § 103.

Claims 7 and 13 are independent claims.

II. Amendments

Claims 7 and 13 have been amended to more particularly claim what Applicant believes is the inventions therein. Support for the amendments may be found at least at paragraph 29-37 of Applicant's disclosure.

No new matter has been added.

III. Prior Art Rejections

A. Claims 7-8, 10 and 13-17 stand rejected under 35 U.S.C. § 102(b) as being unpatentable over Williams (U.S. Pat. 5,815,794) in view of Martin (U.S. Pat. 5,020,129).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *Ecolchem Inc. v. Southern California Edison Co.*, 227 F.3rd 1361, 56 U.S.P.Q.2d (BNA) 1065 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2D (BNA) 1614, 1617 (Fed. Cir. 1999); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992); and *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). See also MPEP 2143.01.

Neither Williams nor Martin, taken alone or in combination, disclose or suggest each and every limitation of independent claims 7 or 13. Williams does not disclose to selectively provide unimpeded, partially impeded, and full cut off of cable service in the upstream or downstream and upstream paths, as recited by amended claims 7 and 13, respectively. Williams only uses the diplex filter 370 to separate the upstream communication signal from the downstream signal, i.e. Williams also does not provide any filtering to the separated upstream communication signal. The Office action appears to recognize these deficiencies of Williams. Office action, pg. 3.

Martin merely teaches a downstream filtering technique to selectively provide premium content channels to a user. Martin, Abs.; Fig. 1; col. 5: 19-42. Moreover, Martin is not concerned with filtering an upstream communication signal. More particularly, Martin does not disclose “a controller for selectively providing unimpeded, partially impeded, and full cut off of cable service in the upstream path, and controlling upstream gain and attenuation in the upstream path, wherein the level of attenuation depend on a maximum upstream level from an interface associated with the RF module and the selection by the controller of providing an unimpeded, partially impeded, or full cut off of cable service in the upstream path”, as substantially recited by each of claims 7 and 13.

Accordingly, neither Williams nor Martin, taken alone or in combination disclose or suggest all of the limitations of claims 7 or 13, the combination of Williams and Martin does not render these claims unpatentable. Further, the combination of Williams and Martin, as applied against claims 7 and 13 is based on illusory motivation and is improper. Likewise, claims 8 and 10, which depend on claim 7, and claims 12-17, which depend on claim 13 are not rendered unpatentable by the combination.

B. Claims 9, 12, 18 and 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Williams in view of Martin and in view of Jung (U.S. Pat. 6,678,893).

Neither Williams, Martin nor Jung taken alone or in combination, disclose or suggest to selectively provide unimpeded, partially impeded, and full cut off of cable service in the upstream or downstream and upstream paths, as recited by amended claims 7 and 13, respectively. Neither Williams nor Martin disclose such as discussed above. Jung also does not disclose such. The Office action appears to rely on Jung to meet the limitations of claims 12, 18 and 19, which pertain to power equalization. Jung discloses to produce a “pilot signal” and send it to the headend to provide a reference signal level to be used for automatic gain control (AGC). Jung, Fig. 5; col. 3: 19-38; cols. 13 and 14. Jung further discloses a conventional attenuator, PAD 501, but does not disclose or suggest controlling the attenuation such that the level of attenuation depends on a maximum upstream level from an interface associated with the RF module and the selection by the controller of providing an unimpeded, partially impeded, or full cut off of cable service in the upstream path. Accordingly, Jung does not cure the deficiencies in the combination of Williams and Martin.

Accordingly, as neither Williams, Martin nor Jung taken alone or in combination, disclose or suggest all of the elements of claims 7 or 13, claim 12 which depends on amended claim 7, and claims 18 and 19 which depend on amended claim 13 are not rendered unpatentable by the combination of Williams, Martin and Jung.

IV. Conclusion

Having fully responded to the Office action, the application is believed to be in condition for allowance. Should any issues arise that prevent early allowance of the above application, the examiner is invited contact the undersigned to resolve such issues.

To the extent an extension of time is needed for consideration of this response, Applicant hereby request such extension and, the Commissioner is hereby authorized to charge deposit account number 502117 for any fees associated therewith.

Respectfully submitted,

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